

REMARKS

Upon entry of the foregoing Amendment, claims 1-4, 6-9, 11-19, and 21-36 are pending in the application. No claims are amended. New claim 36 is added. In view of the following remarks, reconsideration and allowance of all the claims pending in the application are respectfully requested.

Status of the Claims

Claims 1, 6, 11, 16, and 33-35 have been rejected under 35 USC § 103(a) as allegedly being unpatentable over U.S. Patent Number 5,913,032 issued to Schwartz et al. ("Schwartz") in view of U.S. Patent Number 6,044,372 issued to Rothfus et al. ("Rothfus"). Claims 2-3, 7-8, 14-15, and 17-18 have been rejected under 35 USC § 103(a) as allegedly being unpatentable over Schwartz in view of Rothfus and further in view of U.S. Patent Number 6,141,653 issued to Conklin et al. ("Conklin"). Claims 4, 9, 12, 19, and 21-32 have been rejected under 35 USC § 103(a) as allegedly being unpatentable over Schwartz in view of Rothfus and further in view of U.S. Patent Number 6,020,980 issued to Freeman ("Freeman").

Rejections Under 35 USC § 103(a)

Independent claims 1, 6, 11, and 16 have been rejected as allegedly being unpatentable over Schwartz in view of Rothfus. Applicants respectfully submit that the asserted rejection is improper because the references cited by the Examiner, either alone or in combination with one another, fail to teach all the features of the claims. In addition, Applicants respectfully submit that the asserted rejection is improper because the Examiner failed to provide proper motivation to combine the cited references. Applicants provide a discussion of the requirements for a *prima facie* case of obviousness under 35 U.S.C. § 103(a) and an application of these requirements to each claim.

Requirements for prima facie case of obviousness

As stated in the MPEP § 2143, three requirements must be met to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a).

The requirements are: (1) the prior art must teach or suggest all the claim limitations, (2) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or combine reference teachings, and (3) there must be a reasonable expectation of success.

Applicants respectfully submit that at least the first two of these requirements are not met by the asserted rejection. Therefore, Applicants examine those requirements in further detail.

All of the claim limitations must be taught or suggested

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

Suggestion or Motivation to modify the references

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

Claim 1 includes the features of “selection formula is programmed with search criteria corresponding to the subscription,” and that the “search criteria identify information to be searched for and presented to the user at various intervals without additional user intervention.” At least these features are not

disclosed, taught or suggested by Schwartz or Rothfus, either alone or in combination with one another.

The Examiner alleges that Schwartz discloses a selection formula presented to the user at various intervals without additional user intervention (See the Office Action, page 3). Apparently, the Examiner is relying on various references in Schwartz to formulas, macros, and commands in a spread sheet to teach these features of the claimed invention. (See *e.g.*, Schwartz, col. 9, lines 25-45, col. 16, lines 55-67, col. 17, lines 1-12).

Applicants respectfully submit that Schwartz teaches an object exchange system for publishing documents and for providing changed document via subscription to other users. These documents may include, *inter alia*, spreadsheets. Thus, the formulas, macros, and commands within the spreadsheets have no relation whatsoever to the subscription. In fact, these formulas are not for the purpose of entering or specifying search criteria for the subscription as set forth by the Examiner. Rather, these formulas are merely incidental to the underlying documents (i.e., spreadsheets)

Ruthfus does not provide any teaching or suggestion to make up for deficiencies of Schwartz; neither do Conklin or Freeman. For at least this reason, Applicants respectfully submit that the rejection of claim 1 is improper. Therefore, Applicants respectfully request that the rejection be withdrawn.

The Examiner asserts that Schwartz does not explicitly indicate the selection formula programmed with search criteria corresponding to the subscription search criteria that identifies information to be searched for subscription requesting means for enabling a user to request a subscription (See the Office Action, pages 3 and 4). Apparently, the Examiner relies on the references in Rothfus to search subscription request permission and subscription requesting means in order to combine Schwartz and Rothfus to teach these features as set forth in claim 1.

Applicants respectfully submit that the asserted combination of Schwartz and Rothfus is improper for failing to provide some proper suggestion or motivation to modify the references or combine reference teachings. The

Examiner's stated motivation for combining the references is "[i]t would have been obvious to one of ordinary skill in the art, having the teachings of Schwartz and Rothfus at the time the invention was made to modify the formula taught by Schwartz to include the search criteria corresponding to the subscription and that the search criteria identifying information to be searched for and presented to the user at various intervals without additional user intervention..." See Office Action, page 4. As set forth above, the formula taught by Schwartz has nothing to do with defining search criteria.

Thus, the Examiner has not supplied a suggestion or motivation from the references or anywhere else in the prior art as to why one of ordinary skill would modify the teachings of Schwartz or Rothfus to achieve the claimed invention. Applicants respectfully submit that, in fact, there is no motivation for combining the references. For at least this reason, Applicants respectfully request that the rejection be withdrawn.

For the sake of argument, even if Schwartz and Rothfus can be combined, the combination would teach publishing a spreadsheet document and enabling the internet users to subscribe the spreadsheet document. The formulas in this combination are still incidental to the underlying spreadsheet and do not specify search criteria for the subscription. Therefore, Applicants respectfully submit that the combination does not teach or suggest the features of the claimed invention. For at least this additional reason, Applicants respectfully submit that the rejection of claim 1 is improper. Therefore, Applicants respectfully request that the rejection of claim 1 be withdrawn.

Claims 6, 11, and 16 include features similar to those discussed above with regard to claim 1. For at least these reasons, Applicants submit that the rejection of these claims are improper and must be withdrawn.

Dependent claims 2-4, 7-9, 12-15, 17-19, and 21-35 each depend from and add additional features to one of independent claims 1, 6, 11, and 16. Because the references cited by the Examiner, alone or in combination with one another, fail to teach or suggest each of the features of the independent claims,

Applicants respectfully submit that dependent claims 2-3, 7-8, 14-15, and 17-18 are also patentable for at least the reasons set forth above.

New claim 36 includes the features of “enabling a user to input search criteria specifying the information to which the user wants to subscribe, said search criteria including a search formula; performing a search in the plurality of databases to identify the information corresponding to said search criteria and said search formula, wherein said search is performed periodically and automatically without additional user’s input; retrieving said identified information; and presenting said retrieved information to the user.” Applicants respectfully submit that this combination of features is not taught or suggested by the cited references, alone or in combination with one another. For at least the foregoing reason, new claim 36 is patentable over the cited references.

CONCLUSION

Applicants respectfully submit that this application is in condition for allowance and such disposition is earnestly solicited. If the Examiner believes that a telephone conference or interview would advance prosecution of this application in any manner, the undersigned stands ready to conduct such a conference at the convenience of the Examiner.

Respectfully submitted,

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